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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	WALTER GUENTER - 1 (PCT)(CPA)(RCE)		
SERIAL NO.:	09/319,828	EXAMINER:	S. AHMED
FILED:	JUNE 11, 1999	GROUP:	1773
TITLE:	PLASTIC LAYER		

LETTER TRANSMITTING CORRECTED APPEAL BRIEF IN RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH 37 CFR 1.192(c)

MAIL STOP APPEAL BRIEF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliance with 37 CFR 1.192(c) dated August 18, 2004, enclosed are three copies of Appellant's Brief (Corrected) in the above-identified appeal. The Status of Claims section of the Brief has been rewritten to recite the status of all pending and cancelled claims and to identify the appealed claims in compliance with 37 CFR 1.92(c)(3). It is believed that a correct copy of the appealed claims 15, 19, 20, 22 and 32 appears as an Appendix to the Brief as the Amendment After Final filed February 3, 2004 was not entered by the Examiner. As the Official fee for filing an Appeal brief was enclosed with the Appeal brief submitted on June 2, 2004, it is believed that no fee is due at this time. Fee deficiencies, if any, should be charged to Deposit Account No. 03-2468.

Respectfully submitted,
WALTER GUENTER - 1 (PCT)(CPA)(RCE)

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 2, 2004.

Maria Guastella

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BRIEF IN SUPPORT OF APPEAL (CORRECTED)

MAIL STOP APPEAL BRIEF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an appeal from the final rejection of claims 15, 19, 20, 22 and 32, dated November 4, 2003.

REAL PARTY IN INTEREST

The real party in interest is the Assignee, 4P Folie Forchheim GmbH.

RELATED APPEALS AND INTERFERENCES

The Appellant and the Appellant's legal representatives know of no other appeals and interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-14, 16-18, 21 and 23-31 have been canceled without prejudice. Claims 15, 19, 20, 22 and 32 were finally rejected in an Office Action dated November 4, 2003. No claims have been allowed. The appealed claims are 15, 19, 20, 22 and 32.

STATUS OF AMENDMENTS

An Amendment After Final filed February 3, 2004 was not entered.

SUMMARY OF THE INVENTION

The present invention provides a self-carrying plastic film comprising materials having release properties towards adhesives wherein the materials having release properties comprise silicone compounds incorporated as additives within the plastic film and are extruded together with the film, the materials being bound within the film so as to prevent substantial diffusion of the materials into the adhesive when the film is disposed thereon.

Films or sheets (plastic, paper or metal) coated with adhesives have to be provided with a cover sheet for the adhesive that has release properties vis-a-vis the adhesive. With labels this cover is a separate cover sheet that can be peeled off whereas with adhesive tapes, the back side of the carrier film is

provided in most cases with a coating that has release properties. The application of this release coating in the course of manufacture is costly because a separate production step is required for that purpose.

In contrast to prior plastic films in which the release materials are applied to a plastic film or a similar substrate in a separate operation, the plastic film of Applicant's invention provides the release properties earlier in the course of the production process by incorporating the materials that produce the release properties in the plastic layer so that these materials can be extruded with the plastic film. In this way, not only is production facilitated but also the level of the release properties may be easily set. In addition, the materials having release properties are anchored relatively tightly in the plastic film and during storage diffuse into the neighboring adhesive to only a small extent if at all.

The plastic film in accordance with the invention is self-carrying and therefore can be used as a single-layer material or be extruded onto a substrate layer such as a plastic film or paper web.

According to one aspect of this invention, the self-carrying plastic film is a single layer film having release properties toward adhesives. The materials having the release properties may be embedded into a matrix of the plastic film and may further comprise inorganic fillers. The thickness of the plastic film may be about 5μm.

According to another aspect of the invention, the self-carrying plastic film comprises silicone compounds and polyolefin compounds as the materials having release properties toward adhesives.

ISSUES

Claims 15, 19, 20 and 32 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Wilkie U.S. Patent No. 5,981,047*. Claims 15 and 22 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Higgins U.S. Patent No. 5,932,352*.

The Examiner has held *Wilkie* to disclose a coextruded polyolefin packaging film comprising a core layer having a cold seal release layer formed thereon (Column 3, lines 47-51), which she says corresponds to the plastic film of the claimed invention. She further stated that the release layer composition

of *Wilkie* comprises polybutylene, a second polymeric blend, and non-migratory slip agent in an amount sufficient to decrease the coefficient of friction of the release layer. The release layer composition is said to correspond to the materials having release properties toward adhesives and meet the limitation that such materials do not diffuse into an adhesive when the plastic film is disposed next to an adhesive.

The amount of the slip agent is said to indicate that the slip agent is embedded in the polymeric materials and to meet the limitation of claim 19. The Examiner has further stated that examples of such non-migratory slip agents include cross-link silicone particles and various inorganics such as talc, silica, glass beads and clay (Column 5, lines 25-31, lines 56-67 and Column 6, lines 1-3) which is said to correspond to the silicone compound of the claimed invention as recited in claim 15 and to the inorganic fillers of the claimed invention as recited in claim 20, respectively. She has further stated that a matte-finish film surface can be obtained by embossing (Column 2, lines 54-58).

The Examiner has also interpreted the term "self-carrying" to mean a film that can be extruded together with additional layers in view of the Specification and Applicant's statements

that Applicant's self-carrying film "can be extruded together with additional layers." According to the Examiner, because the release layer in *Wilkie* can be co-extruded, the cold seal release layer disclosed by *Wilkie* meets the "self-carrying" limitation.

Claim 15 has also been held anticipated by *Higgins*, along with claim 22 which is rejected solely on *Higgins*. As to claims 15 and 22, the Examiner takes the position that *Higgins* discloses a release film comprising a polymeric film substrate and a release layer formed from a silicone resin and a curable polymer (Column 1, lines 57-61). The release layer is said to correspond to the plastic film of the claimed invention. The silicone resin is said to correspond to the material having release properties toward adhesives and to meet the limitations that the materials having release properties comprise silicone compounds and do not diffuse into an adhesive when the plastic film is disposed next to an adhesive. The Examiner has also stated that the silicone resin may be a polysiloxane (Column 4, lines 35-37) and that the release film may vary in thickness depending on the application and may be in the range of 5 to 350 microns (Column 8, lines 43-48), thus meeting the limitation of claim 22.

Again, the Examiner has interpreted the term "self-carrying" to mean a film that can be extruded together with additional

layers in view of the Specification and Applicant's statements that Applicant's self-carrying film "can be extruded together with additional layers." According to the Examiner, because the release layer disclosed by *Higgins* could be co-extruded, the release layer disclosed by *Higgins* meets the "self-carrying" limitation.

Furthermore, the Examiner has interpreted the limitation that the material having release properties is extruded together with the plastic film to be a process limitation and the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. In the Examiner's view, the product (i.e. the plastic film) is the same despite the process limitation of extruding given that the material having release properties is bound within the film.

GROUPING OF CLAIMS

Appellants will argue that claims 15 and 32 are each patentable on their own merits while all the other claims are argued to be allowable with the claim on which they depend.

ARGUMENT

As to claim 15, which is rejected as anticipated by either of *Wilkie* or *Higgins*, it should be noted that Applicant's invention is a self-carrying single layer plastic film in which no additional support layer is necessary so that the single layer film may be extruded with the materials that have release properties without a support layer.

Wilkie's release layer is not self-carrying but rather is constructed of several layers, and the release layer has no mechanical firmness in the sense of a self-carrying film. Thus, *Wilkie*'s release layer is not self-carrying but, rather, must be co-extruded with the core layer.

Similarly, the film according to *Higgins* is constructed of several layers and *Higgins* requires a release layer to be disposed on a polymeric substrate in order to support the release layer.

Accordingly, it is respectfully submitted that Applicant's "self-carrying single layer" plastic film is neither disclosed nor suggested by either *Wilkie* or *Higgins* which are constructed of several layers and have no mechanical firmness in the sense of a self-carrying film. In contrast to *Wilkie* and *Higgins*, no additional support layer is necessary in Applicant's single layer self-carrying plastic film as recited in claim 15.

Simply put, neither *Higgins* nor *Wilkie* discloses a self-carrying plastic film from a single film layer that has release properties nor is there any disclosure or suggestion to form a release layer as a "self-carrying single layer" film.

The specification states at page 3, lines 4-5 that:

> "The plastic layer in accordance with the invention can be used as a single-layer material. This single-layer material can be extruded onto a substrate layer."

Applicant has also stated in remarks accompanying a Response submitted on January 30, 2002 that Applicant's self-carrying film "can be extruded together with additional layers." Because of these statements, the Examiner has taken the position that the release layers of the multilayer films of *Wilkie* and *Higgins* meet the "self-carrying" recitation of Applicant's claims. Applicant

respectfully disagrees. Applicant's self-carrying film may be formed as a relatively thin layer which can be attached to a carrying layer by coextrusion. Applicant's film, however, need not be applied to a substrate film as it is self-carrying. Thus, Applicant's films must have sufficient firmness to be "self-carrying" even if they are thin enough to be attached to a carrying layer. *Wilkie* and *Higgins* release layers in their multilayer films are not self-carrying as they lack the requisite mechanical firmness. Thus, the release layers of the multilayered films of *Wilkie* and *Higgins* are outside the scope of claim 15 which requires a self-carrying single layer plastic film.

According to *Wilkie*, manufacture of the multilayer film is carried out by coextrusion of the various layers, including coextruding through a flat film die, the melt corresponding to the individual layers, cooling the film, orienting the film, and heat-setting the stretched film. The film can also be coextruded by the blown film or double bubble orientation process (Col. 9, lines 10-21). In addition, the film can be extrusion-coated onto a machine-direction-oriented sheet prior to transverse direction orientation (Col. 9, lines 30-33). The release layer in *Higgins* is formed by coating a substrate with the silicone resin/polymer

mixture and then curing the mixture to form a release layer on the substrate.

Thus, the release layer of each of Wilkie and Higgins is different from Applicant's self-carrying film. In *Wilkie's* film, the release layer must be placed on a substrate in order to stretch it. In *Higgins'* film, the release layer must be placed on a substrate in order to cure it. Neither *Wilkie* nor *Higgins* make any mention of a self-carrying single layer film. Although the Examiner has stated that Applicant's film is the same as *Higgins'* film despite the recitation in claim 15 that the material having release properties is extruded together with the film, Applicant respectfully disagrees. If *Higgins'* film were the same as Applicant's self-carrying film, there would be no reason in *Higgins* to apply the release composition to the substrate film surface by conventional coating techniques.

Claim 32, which is rejected only on *Wilkie*, recites a self-carrying plastic film in which the materials having release properties comprise silicone compounds and polyolefin compounds incorporated as additives within the plastic film and extruded together with the film. As discussed above, *Wilkie* requires the release layer to be disposed on a polymeric substrate in order to support the release film. The release layer in *Wilkie* has no

mechanical firmness in the sense of a self-carrying film. Hence, *Wilkie* fails to meet the "self-carrying" feature of Applicant's plastic film.

An "anticipating" reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention. Merck & Co. v. Teva Pharmaceuticals USA, Inc., 68 U.S.P.Q.2d 1857, 1861 (Fed. Cir. 2003). Such description of a "self-carrying single layer plastic film having release properties towards adhesives" as recited in claim 15 is absent in *Wilkie* and *Higgins*. Similarly, a description of a "self-carrying plastic film adapted to be releasably disposed on an adhesive" as recited in claim 32 is absent in *Wilkie*.

Accordingly, it is respectfully submitted that claims 15, 19, 20, 22 and 32 are clearly patentable.

In view of the above, Appellant respectfully submits that they are entitled to a patent incorporating claims 15, 19, 20, 22 and 32 under 35 U.S.C. § 102. An Appendix containing the appealed claims is attached to this brief submitted in triplicate. A remittance of $330.00 in payment of the Official

fee was made on June 2, 2004. Fee deficiencies, if any, should be charged to Deposit Account No. 03-2468.

Respectfully submitted,
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Enclosure: Appendix

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 2, 2004.

Maria Guastella

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APPENDIX

Claims 15, 19, 20, 22 and 32

Claim 15: A self-carrying single layer plastic film having release properties towards adhesives and being adapted to be releasably disposed on an adhesive, comprising materials having release properties towards adhesives, wherein the materials having release properties comprise silicone compounds incorporated as additives within the plastic film and are extruded together with said film, said materials being bound within the film so as to prevent substantial diffusion of said materials into the adhesive when said film is disposed thereon.

Claim 19: The plastic film according to claim 15, wherein the materials having the release properties are embedded into a matrix of the plastic film.

Claim 20: The plastic film according to claim 15, wherein the materials having the release properties further comprise inorganic fillers.

Claim 22: The plastic film according to claim 15, wherein the thickness of the plastic film is about 5 μm.

Claim 32: A self-carrying plastic film adapted to be releasably disposed on an adhesive, comprising materials having release properties towards adhesives, wherein the materials having release properties comprise silicone compounds and polyolefin compounds incorporated as additives within the plastic film and are extruded together with said film, said materials being bound within the film so as to prevent substantial diffusion of said materials into the adhesive when said film is disposed thereon.